

### **REMARKS**

The present submission is submitted in response to an Office Action dated February 23, 2004 in which Claims 1-21 have been rejected under 35 U.S.C. §101. Claim 1-21 have also been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication No. US 2002/0007318 to Alnwick in view of Official Notice. Claim 3 has been objected to due to formalities. Claim 2 has been canceled. Claims 1 and 3-10 have been amended. The Applicant submits that the instant application is in condition for allowance for at least the reasons set forth below. No new matter has been entered.

### **Objections**

Claim 3 has been objected to because of informalities. The Applicant has amended claim 3 accordingly and thanks the Examiner for his suggestion.

### **35 USC 101**

Claims 1-21 have been rejected under 35 USC 101 for allegedly failing to provide a connection to the technological arts. The Applicant has amended claims 1 and 3-10 to include reference to the technological arts as required by the Examiner. The Applicant submits that amended claims 1 and 3-10 properly recite a connection to the relevant technological arts and, accordingly, are in condition for allowance. The Applicant respectfully requests reconsideration of the outstanding rejections of claims 1 and 3-10. Claim 2 has been canceled. Claims 11-19 are directed to methods for backordering out of stock products. Claims 20 and 21 are directed to storage mediums for backordering out

of stock products. The Applicant submits that the classes of claims recited in claims 11-19 and 20-21 are proper bases of statutory subject matter in accordance with 35 USC 101. Accordingly, the Applicant respectfully requests reconsideration of the rejections of claims 11-21.

### 35 USC 103

Claims 1-21 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Alnwick in view of Official Notice. The Applicant respectfully disagrees. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

The Applicant's amended claim 1 recites a host system "receiving an order for a product from [a] user system;

determining whether inventory for said product satisfies said order;

notifying said user system if said inventory for said product does not satisfy said order;

receiving a back order request from said user system to back order said product if said inventory for said product does not satisfy said order;

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*OWK claim 1* receiving a time period request from said user system for setting a time that said back order request is to remain in effect;

determining an amount of said product for meeting said back order request;

*OWK {orig}* acquiring said amount and updating said inventory;

*OWK {orig}* notifying said user system that said back order request has been satisfied; and

*NEW* in response to said notifying said user that said back order request has been satisfied, receiving a delivery request from said user system to deliver said product." (emphasis added)

Alnwick does not recite these features. Specifically, Alnwick does not recite receiving a time period request from said user system for setting a time that said back order request is to remain in effect; and acquiring said amount and updating said inventory. Nor does Alnwick recite notifying said user system that said back order request has been satisfied. Moreover, Alnwick does not teach or suggest "in response to said notifying said user that said back order request has been satisfied, receiving a delivery request from said user system to deliver said product." Rather Alnwick teaches an exchange platform that allows buyers and sellers to engage in the resale of computer components (p. 1, par. 12, par. 15). A number of vendors submits inventories for review by a number of exchange customers (p. 1, par 14). Thus, the Alnwick reference recites a broker-based model for "reselling computer parts which allows customer to almost instantaneously determine available inventory, correlate to a manufacturer part number, and rapidly place the order" (p. 1, par. 11). A back order in the instant application may be maintained for a user-selected time period as provided in Applicant's claim 1. Thus, the instant application provides a purchase and ordering scheme that is not time-critical as emphasized in the Alnwick reference.

Moreover, a delivery request is received from a user to delivery a product in response to notification that the back order request has been satisfied (Applicant's claim 1). Contrary to the instant application, the order and delivery process recited in the

Alnwick reference is directed to special shipping instructions for delivery of goods, e.g., to alternate addresses, etc. (p. 6, par. 78). The Alnwick reference does not recite receiving a delivery request from a user in response to notification that a back order has been satisfied.

In the instant application, the user places an order (e.g., back order) when the product is not readily available in inventory. The customer specifies a time that the back order request is to remain in effect. This feature is not recited in Alnwick. The Examiner has taken Official Notice that such action is common and well known in the art. The Applicant respectfully disagrees and submits that the Examiner's use of Official Notice in this circumstance is improper. MPEP § 2144.03 defines when it is proper to use Official Notice. In particular, the MPEP states "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." The MPEP also states "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." The MPEP gives as an example specific knowledge of the art. In this case, the limitations of a time specified by the user in which a back order request is to remain in effect is not capable of instant and unquestionable demonstration as being well-known. Applicant asserts that it is improper to rely on Official Notice for the limitation recited in claim 1, which has been amended to include the limitation of claim 4 for which the Official Notice is taken. The Applicant further submits that the Official Notice taken for the limitation updating the inventory after the back ordered product is received and the customer notified is also improper for at least the reason stated above.

For at the least the foregoing reasons, the Applicant submits that claim 1 is patentable over Alnwick in view of Official Notice. The Applicant respectfully requests reconsideration of the outstanding rejections. Claims 3-10 depend from what is an allowable claim 1 and for at least this reason, the Applicant submits that claims 3-10 are

in condition for allowance. Reconsideration is respectfully requested.

In regards to claims 7 through 21, the Examiner has indicated that these claims and their features are allegedly considered to be parallel claims to claims 1-7 and has rejected claims 7-21 for same reasons that claims 1-7 were rejected. The Applicant respectfully disagrees and submits that, for example, claim 7 includes supplier-directed activities whereas claim 1, for example, is directed to user (or customer) directed activities. In particular, Applicant's claim 7 recites: "a host system;

a user system in communication with said host system via a network;

a supplier system in communication with said host system via said network; and

a database coupled to said host system, said database storing data relating to said back ordering out of stock products;

wherein host system includes instructions for implementing a method, comprising:

receiving an order for a product from said user system;

determining whether inventory for said product satisfies said

order;

notifying said user system if said inventory for said product does not satisfy said order;

receiving a back order request from said user system to back order said product if said inventory for said product does not satisfy said order;

*sending a supplier request to said supplier system for fulfilling said back order request;*

*receiving an inventory update request from said supplier system, wherein said inventory update request includes an amount of said product for fulfilling said back order request;*

notifying said user system that said back order request has been satisfied; and

receiving a delivery request from said user system to deliver said product." (emphasis added)

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In addition to the limitations described above with respect to claim 1, these supplier-side activities recited in the limitations of amended claim 7 are not taught by the Alnwick reference. For at least this reason and the reasons provided above with respect to claim 7, the Applicant submits that claim 7 is in condition for allowance. Additionally, claims 8-10 depend from what is an allowable claim 7. For at least this reason, the Applicant submits that claims 8-10 are in condition for allowance. Reconsideration of the outstanding rejections is respectfully requested.

The Applicant submits that claims 11 and 20 are in condition for allowance at least for the reasons provided above with respect to claim 1. Claims 12-15 depend from what should be an allowable claim 11 and are accordingly believed to be in condition for allowance. The Applicant submits that claims 16 and 21 are in condition for allowance at least for the reasons provided above with respect to claim 7. Claims 17-19 depend from what should be an allowable claim 16 and are accordingly believed to be in condition for allowance. The Applicant respectfully requests reconsideration of the outstanding rejections.

No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,

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